

## REMARKS

Upon entry of the present amendment claims 1-2, 4-9, 12-18, and 21-22 are pending in the application. Claims 1, 5, 9 and 18 have been amended, claims 19-20 have been canceled, and claims 21-22 have been added in accordance with the requirements of U.S. patent practice. Claims 3, and 10-11 have been canceled; leaving claims 1-2, 4-9, and 12-20 for consideration upon entry of the present amendment.

Amendments to the claims and new claims, as set forth above, are made in order to streamline prosecution in this case by limiting examination and argument to certain claimed embodiments that presently are considered to be of immediate commercial significance. Amendment of the claims is not in any manner intended to, and should not be construed to, waive Applicants' right in the future to seek such unamended subject matter, or similar matter (whether in equivalent, broader, or narrower form) in the present application, and any continuation, divisional, continuation-in-part, RCE, or any other application claiming priority to or through the present application, nor in any manner to indicate an intention, expressed or implied, to surrender any equivalent to the claims as pending after such amendments or cancellations.

### **1. Claim Amendments and New Claims**

Claims 1 and 5 have been amended to include the limitation that "the at least one binder (A) in component (I) is different than the at least one binder (A) in component (III)." Support for this amendment can be found at least at p. 25, l. 6 to p. 29, l. 9 of the Application as filed.

Claims 5 and 9 have been amended to correct informalities as required by the PTO.

Claim 18 have been amended to include the process step of "mixing components (I), (II) and (III) of the multicomponent system of claim 1 to form an oil-in-water dispersion." Support for this amendment can be found at least at p. 26, l. 1 to p. 30, l. 6.

New claims 21 and 22 have been drafted to more specifically claim the invention. Claim 21 recites that "the at least one oligomeric and/or polymeric binder (A) in component (I) is selected from the group consisting of a water-soluble or water-dispersible methacrylate

copolymer, a hydrophobic polyester, and combinations thereof.” Support for this amendment can be found at least at p. 26, l. 1 to p. 27, l. 8, and p. 27, l. 20 to p. 28, l. 29.

Claim 22 recites that “the at least one binder (A) in component (III) is selected from the group consisting of water-soluble or water-dispersible methacrylate copolymer, a water-soluble or water-dispersible polyester, and combinations thereof.” Support for this amendment can be found at least at p. 25, ll. 6-27.

**2. Objection to Claims 5 and 9.**

The informalities objected to by the PTO have been corrected.

**3. Rejection of claims 1-2 and 13-18 under 35 U.S.C. §102(b) as being anticipated by Fiori et al., U.S. Patent No. 6,313,218, hereafter “Fiori”.**

Fiori generally discloses a process for making a low volatile organic content, isocyanate based, curable, oil-in-water emulsion comprising the steps of (i) mixing an isocyanate crosslinking agent (a) with (b), wherein (b) is a water-in-oil emulsion comprising a water dispersible, surface active isocyanate reactive material (b1) and an aqueous medium (b2), and (ii) mixing the water-in-oil emulsion of step (i) with an aqueous medium to produce a curable oil-in-water emulsion having a VOC content of about 2.1 lbs/gal (252 g/L) or less (col. 3, ll. 17-44).

With respect to claim 1, the PTO alleges that Fiori teaches limitation (III) because an aqueous binder composition corresponding to (III) is generated by mixing component I (corresponding to (b1) of Fiori) with water (col. 18, lines 40-45). Applicants appreciate the detailed basis of rejection, but must respectfully disagree, at least to the extent that it applies to claim 1 as herein amended.

When a small amount of water is mixed with component I corresponding to (b1) of Fiori, a water-in-oil emulsion, not an oil-in-water emulsion, is obtained (col. 12, ll. 10-20). Limitation III of claim 1 is a dispersion and/or solution of Binder A and solvent in water. i.e. an oil-in-water dispersion, not a dispersion of water in a dispersion and/or solution of Binder A and solvent, i.e. a water-in-oil dispersion..

Although an oil-in-water dispersion of (b1) (along with the polyisocyanate (a)) is ultimately generated by mixing (b1) with (a), and then water, the resulting oil-in-water dispersion

is the final composition comprising (b1), (a), and water. Claim 1 of the present application, on the other hand, does not recite a mixture of components (I), (II), and (III). Claim 1 recites instead, a multicomponent system comprising these three separate components, i.e. a three-component coating composition.

Moreover, claim 1 as herein amended has the limitation that “the at least one binder (A) in component (I) is different than the at least one binder (A) in component (III).” Since Fiori does not teach a component (III) comprising at least one binder (A), and does not teach that the at least one binder (A) in component (III) is different than the at least one binder (A) in component (I), Fiori does not anticipate claim 1. Therefore reconsideration, and removal of the anticipation rejection of claim 1 and claim 2, which depends therefrom, is respectfully requested.

With respect to claim 18, the PTO alleges that Fiori teaches a method of coating a substrate by applying the composition to a substrate (col. 11, lines 20-25) and curing thermally (col. 11, lines 29-36).

Applicants greatly appreciate the detailed basis of this rejection but must respectfully disagree, at least to the extent that the rejection applies to claim 18 as herein amended. Claim 18 has the process step of mixing components (I), (II) and (III) of the multicomponent system of claim 1 to form an oil-in-water dispersion. For the reasons set forth in Section 3 of this paper, Fiori does not teach component (III) of the multicomponent system of claim 1, and therefore does not teach mixing components (I), (II), and (III) of the multicomponent system of claim 1. Since Fiori does not teach this process step, claim 18, and claims 13-17, which depend therefrom, are not anticipated by Fiori. Reconsideration and removal of the anticipation rejection of these claims is therefore respectfully requested.

#### **4. Rejection of claims 5-9 and 12 under 35 U.S.C. §103(a) as obvious over Fiori.**

With respect to claim 5, the PTO alleges that Fiori teaches that an aqueous binder composition corresponding to component (III), is generated by mixing a component corresponding to component (I'), i.e. (b1), with water (col. 18, lines 40-45) to generate the equivalent of component (I).

Applicants greatly appreciate the detailed basis of rejection but must respectfully disagree. Component (I) is a water-in-oil emulsion, while component (III) is a oil-in-water dispersion or a solution in water. Also, in the cited passage, a water-in-oil dispersion is generated, which is different than component (III), which is an oil-in-water dispersion or solution in water.

It is also not possible to generate component (III) from component (I) because the oligomeric and/or polymeric binder (A) in component (I) is different than the at least one binder (A) in component (III);

Moreover, Fiori does not teach process step (1) of claim 5 wherein a portion of the at least one component (III) is mixed with the at least one component (I') to give at least one water-in-oil dispersion (I).

Since Fiori does not teach or suggest all the limitations of claim 5 as herein amended, claim 5, as well as claims 6-9 and 12, which depend therefrom, are not obvious over Fiori. Reconsideration and removal of the obviousness rejection of these claims is therefore respectfully requested.

## CONCLUSION

Applicants respectfully submit that the Application and pending claims are patentable in view of the foregoing amendments and remarks. A Notice of Allowance is respectfully requested. As always, the Examiner is encouraged to contact the Undersigned by telephone if direct conversation would be helpful.

Respectfully Submitted,

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